

REMARKS

Reconsideration is respectfully requested of the position set forth in the final rejection dated January 10, 2003. Claims 1 to 6, 8 to 11, 13 to 19 and 21 to 27 are under prosecution with entry of this amendment filed under a Request For Continued Examination.

Newly added claim 27 is dependent on claim 1 and limits the pigment to a group which consists essentially of TiO₂, SiO₂, CaCO₃, Al₂O₃, BaSO₄, carbon black, zeolite and mixtures thereof. Newly amended claim 1 contains these pigments and, in addition, white pigment and voided pigment. Antecedent support exists for these pigments on page 4, lines 6 to 10 in the body of the patent application.

Prior to a discussion of the inapplicability of Shetty et al. USP 5,837,359 under 35 USC 102 or 35 USC 103, it may be helpful to first discuss the scope of claim 1, the sole independent claim under prosecution. Claim 1, as presently amended, recites for the crystalline polyester layer which contains pigment the wording of "wherein the pigment is selected from the group and consists essentially of..." followed by the naming of the pigments. The use of "consists essentially of" limits the claim to the specified materials and steps and those that do not materially affect the basic and novel characteristics of the present claims. Attention is respectfully directed to the Manual of Patent Examining Procedure Section 2111.03 wherein it is set forth:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s) of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

It is directly stated that the wording of the pigments being selected from the group which "consists essentially of" would exclude a pearlescent pigment. The word "pearlescent" is defined as "having the appearance of mother of pearl" in accordance with Webster's Unabridged Third New International Dictionary. As set forth in the Technical Background of the Invention which the present invention is directed:

Thus there is a need for a film that would show good mechanical properties together with good opacity properties, while minimizing the overall pigment content.

In accordance with the above statement, a pearlescent pigment would be excluded from the scope of the need for which the present invention is directed.

Claims 1 to 5, 8 to 11, 13 to 15 and 21 to 26 stand rejected under 35 USC 102(e) as anticipated by Shetty USP 5,837,359. In response to this grounds of rejection, it is pointed out that the Title of this patent is "Satin and Tinted Satin Iridescent Films". The Summary of the Invention states "with the finer particle size of pearlescent pigments..." "on column 1, lines 52 and 53. Also, the Detailed Description of the Invention states:

1. The pearlescent pigments are transparent or translucent to allow the light to pass through to the optical core of the multilayer films and to allow the iridescent colors to pass through the pigments and be visible, resulting in a iridescent film.

This transparent or translucent property is directly contrary to the purpose of the present invention directed to a need for "good opacity property" yet "minimizing the overall pigment content".


The pearlescent pigments disclosed by Shetty et al. are mica platelets coated with an oxide which usually is (titanium dioxide and/or iron oxide) resulting in a transparent pigment which reflects light (column 2, lines 29 to 32). Again, this requirement of the prior art publication lies outside the scope of the present claims invention. Reconsideration and withdrawal of the grounds of rejection is requested.

Claims 16 to 19, as well as claim 12, have been rejected based on Shetty et al. USP 5,837,359 in view of Utsumi et al. USP 5,510,192 under 35 USC 103(a). The additional Utsumi et al. publication does not overcome a requirement for use of a (pearlescent pigment). Accordingly, this combination of publications must fail. Withdrawal of the grounds of rejection is proper.

Although no prior art rejection has been specifically discussed against claim 6, it is considered that the final Office action would have grouped this claim with the combination of the two publications, cited above. However, this claim likewise represents a patentable advance for the reasons previously discussed in detail.

In summary, all claims under prosecution directly exclude a pearlescent pigment. The presence of such pigment would materially offset the basic and novel characteristics of the claimed invention. Withdrawal of all grounds of rejection is proper. A notice of allowance is solicited.

Respectfully submitted,



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